

## REMARKS

Claims 30-32 are pending for prosecution in the present patent application.

The present application was remanded to the Examiner following a Decision on Appeal on August 22, 2002. In the present non-final Office Action of January 28, 2003, the Examiner rejected claims 30-32 under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 4,662,803 to Arnold (hereinafter "the Arnold patent"). In addition, the Examiner has also rejected claims 30-32 under 35 U.S.C. §112, ¶1 and objected to the drawings. In response, the Applicant has amended the specification, enclosed formal drawings and provides the remarks below.

With respect to paragraph 3 of the Office Action, the Applicant has enclosed formal drawings (FIGS. 1-10) to replace the current informal drawings. Applicant submits that new FIGS. 8-10 now clearly show the helical flutes extending longitudinally along the first and second cutting portion. Applicant further submits that no new matter was entered in the enclosed formal drawings. Therefore, Applicant believes that the drawings now clearly show every feature of the invention, as specified in claims 30-32, and respectfully requests that the Examiner now withdraws the present objections.

With respect to paragraph 4 of the Office Action, the Applicant has amended the specification, as provided above, to address the Examiner's rejection under 35 U.S.C. §112, ¶1. The specification has been amended to reasonably convey to one skilled in the relevant art the subject matter of the claims. Specifically, identifiers 154 and 156 were amended to identify a "first cutting portion" and "a second cutting portion," respectively, in order to use language consistent with that found in claims 30-32. The following sentence has also been added:

Helical cutting flutes 160 (as shown in FIGS. 9 and 10)  
extend longitudinally along both the first cutting portion

154 and the second cutting portion 156 of the rotary cutting tool 152.

Applicant submits that the amended portions do not contain any new matter. Rather, matter that was already present in the claims and drawings has simply been clarified. Applicant now believes that the subject matter of the claims is now clearly described in the specification and respectfully requests that the Examiner withdraws the present rejection.

With respect to paragraph 7 of the Office Action, the Applicant respectfully disagrees with the Examiner's rejection of claims 30-32 under 35 U.S.C. §102(b) as being anticipated by the Arnold patent. The Examiner has adopted a new interpretation of the Arnold patent. With respect to claim 30, the Examiner has interpreted Arnold as disclosing "a first cutting portion (18, near element 44) defining a first outer diameter and second cutting portion (12) defining a second outer diameter..." (See Office Action, p. 3, ¶3). The Examiner further notes that:

...Arnold discloses a tapered section (the partial portion of 18 between the first cutting portion (18, near element 44) and the second cutting portion 12); and the first cutting portion (18) and the second cutting portion (12) being generally cylindrical.

(See Office Action, p. 3, ¶4). The applicant respectfully disagrees and traverses the Examiner's rejection below.

With respect to Examiner's rejection of claim 30, the claim language clearly requires that "a first cutting portion defining a first outer diameter." The Encarta World English Dictionary, © Bloomsbury Publishing Plc 1999, defines the word "portion" as "2. FRACTION a part or section of a larger whole." Therefore, the claim clearly requires that the first cutting *portion* – or a part or section of a larger whole – define a first outer diameter.

Conversely, the Arnold patent discloses that:

[t]he reamer 10 comprises a *cylindrical* forward guide portion or core 12 having a first end 14 coupled to a first end 16 of a *conical* rear portion or core 18, such that their longitudinal axes 20 and 21, respectively, are coincident. The rear portion 18 *tapers outwardly* to a second end 22...

(See the Arnold patent, col. 2, lines 56-61). Accordingly, the rear portion (18), which encompasses the "first cutting portion" defined by the Examiner (*i.e.*, "18, near element 44"), of the reamer in the Arnold patent is not "generally

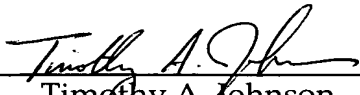
cylindrical". Rather, as is explicitly stated in the specification, the rear portion (18) is conical in shape and tapers outwardly to the second end (22). Because the rear portion 18 is conical in shape and tapers outwardly, there are, by definition, no part or section where the diameter is the same throughout. Rather, as one progresses along the axis of the rear portion toward the second end 22 of the Arnold reamer, the diameter of the core (18) continually changes, becoming larger and larger. Therefore, the conical rear portion (18) of the Arnold patent, or any portion thereof, can not define a first cutting *portion* that defines an outer diameter, let alone have a generally cylindrical shape.

Accordingly, the applicant respectfully submits that the Arnold patent does not anticipate claim 30 of the present patent application because it does not disclose a first cutting *portion* defining an outer diameter as required by claim 30 of the present application. The applicant respectfully submits that the Examiner's rejection in the present matter is, therefore, improper and requests that the present rejection of claim 30 be withdrawn.

Additionally, Claims 31 and 32 are both dependent on claim 30. Applicant submits that these claims are patentably distinguished from the Arnold patent in the same way as claim 30, as well as by virtue of the additional limitations clearly set forth therein. Applicant respectfully requests that the present rejections be withdrawn with respect to these claims, as well.

Applicant believes that no fees are due at this time; however, please charge any deficiencies to our Deposit Account No. 13-0235. Applicant also respectfully requests that the Examiner contact the Applicant's representative at the phone number listed below should the Examiner have any questions regarding the present Response.

Respectfully submitted,

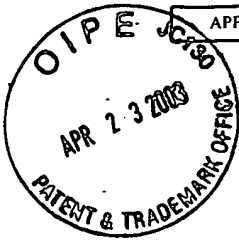
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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/558,575  | 04/26/2000  | Wolfgang M. Strobel  | 48-1229-1<br>R          | 9555             |
| 7590  | 01/28/2003  |                      |                         |                  |
| Richard R Michaud<br>McCormick Paulding & Huber LLP<br>185 Asylum Street<br>CityPlace II<br>Hartford, CT 06103-3402 |             |                      | EXAMINER<br>TSAI, HENRY |                  |
|   |             |                      | ART UNIT<br>2183        | PAPER NUMBER     |

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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McCormick, Paulding & Huber

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R48-1229-1

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APR 29 2003

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# Office Action Summary

Application No.

09/558,575

Applicant(s)

STROBEL ET AL.

Examiner

Henry W.H. Tsai

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

1. Note This Office Action is issued in response to the DECISION ON APPEAL filed on 8/22/02
2. At pages 5-6 of the DECISION ON APPEAL, regarding the limitations of "each of said first and second cutting portion are defined in part by at least two helical cutting flutes extending longitudinally", Examiner considers the supports of the flutes(160) are shown in Figs. 8-10. However, in the specification, the limitations were not described for the written supports. The drawings should be also corrected to consist with the specification after being amended.

Regarding the art rejections, Examiner agree with the board that reference Arnold could still be used to anticipate the claimed invention by different interpretations.

Therefore, in view of the DECISION ON APPEAL filed on 8/22/02, PROSECUTION IS HEREBY REOPENED. A new ground(s) of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

#### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, In claim 30, lines 8-9, the limitations of "each of said first and second cutting portion are defined in part by at least two helical cutting flutes extending longitudinally" must be clearly shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.



***Specification***

4. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 30-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 30, lines 8-9. the limitations of "each of said first and second cutting portion are defined in part by at least two helical cutting flutes extending longitudinally" were not described in the specification.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3722

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (4,662,803)

Arnold discloses the claimed invention comprising: as shown in Fig. 1, a first cutting portion(18, near element 44) defining a first outer diameter and second cutting portion(12) defining a second outer diameter extending from and coaxial with the first cutting portion; and wherein the second cutting portion(12) defines a generally cylindrical, outer peripheral surface; each of the first cutting portion(18) and second cutting portion(12) being defined in part by at least two helical cutting flutes(23,24, 25, and 26, see Fig. 2) extending longitudinally shown in Fig. 1.

Note Arnold also discloses a tapered section(the partial portion of 18 between the first cutting portion(18, near element 44) and the second cutting portion 12); and the first cutting portion(18) and second cutting portion(12) being generally cylindrical shown in Fig. 1.

Note as described in Col. 3, lines 15-16, the flutes(23-26) on the forward portion(12) could be used to make a cylindrical enlargement of the hole prior to tapering. Therefore, the portion 12 is considered as the second cutting portion.

### **Response to Arguments**

8. Applicant's arguments mailed 12/19/00, 6/11/01 and 8/20/01 have been considered but are moot in view of the new ground(s) of rejection.

### **Contact Information**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Henry Tsai whose telephone number is (703) 308-7600. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington can be reached on (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703) 308-1148.

10. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into: the Group at fax number 703-872-9302; and Official faxes for After Final amendments should be sent to 703-872-9303. This practice may be used for filing papers not

Art Unit: 3722

requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.

HENRY W. H. TSAI  
PRIMARY EXAMINER

January 27, 2003

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